



DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

37 CFR Part 1

[Docket No.: PTO-P-2012-0015]

RIN 0651-AC77

Changes To Implement the First Inventor To File Provisions of the Leahy-Smith America Invents Act; Correction

AGENCY: United States Patent and Trademark Office, Department of Commerce.

ACTION: Final rule; correction.

SUMMARY: The United States Patent and Trademark Office (Office) published in the Federal Register of February 14, 2013, a final rule revising the rules of practice in patent cases for consistency with, and to address the examination issues raised by, the changes in the first inventor to file provisions of the Leahy-Smith America Invents Act (AIA) (First Inventor to File Final Rule). Due to a technical issue, the First Inventor to File Final Rule as published in the Federal Register is missing text in the provisions pertaining to claims for priority to a foreign application in an application filed under the Patent

Cooperation Treaty (PCT). This document corrects the omission in the First Inventor to File Final Rule as published in the Federal Register.

DATES: Effective March 16, 2013.

FOR FURTHER INFORMATION CONTACT: Susy Tsang-Foster, Legal Advisor (telephone (571) 272-7711; electronic mail message (susy.tsang-foster@uspto.gov)) or Linda S. Therkorn, Patent Examination Policy Advisor (telephone (571) 272-7837; electronic mail message (linda.therkorn@uspto.gov)), of the Office of the Deputy Commissioner for Patent Examination Policy.

SUPPLEMENTARY INFORMATION: The Office published in the Federal Register of February 14, 2013, a final rule revising the rules of practice in patent cases for consistency with, and to address the examination issues raised by, the changes in the first inventor to file provisions of the AIA. See [Changes To Implement the First Inventor To File Provisions of the Leahy-Smith America Invents Act](#), 78 FR 11024 (Feb. 14, 2013). The First Inventor to File Final Rule as published in the Federal Register is missing text in the provisions pertaining to claims for priority to a foreign application in an application filed under the PCT. See [Changes To Implement the First Inventor To File Provisions of the Leahy-Smith America Invents Act](#), 78 FR at 11053 (to be codified at 37 CFR 1.55(c)). Specifically, the “371” in “35 U.S.C. 371” as it appears in the body of § 1.55(c) in the electronic copy of the First Inventor to File Final Rule submitted to the Office of the Federal Register contained a hyperlink, which is not printed by the Office of the

Federal Register. This document corrects the omission of “371” in “35 U.S.C. 371” in the body of § 1.55(c) in the First Inventor to File Final Rule as published in the Federal Register.

In rule FR Doc. 2013-03453 published on February 14, 2013 (78 FR 11024), make the following corrections:

§ 1.55 [Correction]

1. On page 11053, second column, through page 11055, first column, revise amendatory instruction 6 and its amendatory text to read as follows:

6. Section 1.55 is revised to read as follows:

§ 1.55 Claim for foreign priority.

(a) In general. An applicant in a nonprovisional application may claim priority to one or more prior foreign applications under the conditions specified in 35 U.S.C. 119(a) through (d) and (f), 172, and 365(a) and (b) and this section.

(b) Time for filing subsequent application. The nonprovisional application must be filed not later than twelve months (six months in the case of a design application) after the date on which the foreign application was filed, or be entitled to claim the benefit under 35 U.S.C. 120, 121, or 365(c) of an application that was filed not later than twelve months (six months in the case of a design application) after the date on which the

foreign application was filed. The twelve-month period is subject to 35 U.S.C. 21(b) (and § 1.7(a)) and PCT Rule 80.5, and the six-month period is subject to 35 U.S.C. 21(b) (and § 1.7(a)).

(c) Time for filing priority claim and certified copy of foreign application in an application entering the national stage under 35 U.S.C. 371. In an international application entering the national stage under 35 U.S.C. 371, the claim for priority must be made and a certified copy of the foreign application must be filed within the time limit set forth in the PCT and the Regulations under the PCT.

(d) Time for filing priority claim in an application filed under 35 U.S.C. 111(a). In an original application filed under 35 U.S.C. 111(a), the claim for priority must be filed within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. The claim for priority must be presented in an application data sheet (§ 1.76(b)(6)), and must identify the foreign application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing. The time period in this paragraph does not apply in a design application.

(e) Delayed priority claim in an application filed under 35 U.S.C. 111(a). Unless such claim is accepted in accordance with the provisions of this paragraph, any claim for priority under 35 U.S.C. 119(a) through (d) or (f) or 365(a) in an original application filed under 35 U.S.C. 111(a) not presented in an application data sheet (§ 1.76(b)(6)) within the time period provided by paragraph (d) of this section is considered to have been waived. If a claim for priority is presented after the time period provided by paragraph (d) of this section, the claim may be accepted if the priority claim was unintentionally

delayed. A petition to accept a delayed claim for priority under 35 U.S.C. 119(a) through (d) or (f) or 365(a) must be accompanied by:

(1) The priority claim under 35 U.S.C. 119(a) through (d) or (f) or 365(a) in an application data sheet (§ 1.76(b)(6)), identifying the foreign application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, unless previously submitted;

(2) A certified copy of the foreign application if required by paragraph (f) of this section, unless previously submitted;

(3) The surcharge set forth in § 1.17(t); and

(4) A statement that the entire delay between the date the priority claim was due under paragraph (d) of this section and the date the priority claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(f) Time for filing certified copy of foreign application in an application filed under 35 U.S.C. 111(a). In an original application filed under 35 U.S.C. 111(a), a certified copy of the foreign application must be filed within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application, except as provided in paragraphs (h) and (i) of this section. If a certified copy of the foreign application is not filed within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application, and the exceptions in paragraphs (h) and (i) of this section are not applicable, the certified copy of the foreign application must be accompanied by a petition including a showing of good and sufficient cause for the delay and the petition

fee set forth in § 1.17(g). The time period in this paragraph does not apply in a design application.

(g) Requirement for filing priority claim, certified copy of foreign application, and translation in any application. (1) The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 must, in any event, be filed within the pendency of the application and before the patent is granted. If the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, it must also be accompanied by the processing fee set forth in § 1.17(i), but the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and § 1.323.

(2) The Office may require that the claim for priority and the certified copy of the foreign application be filed earlier than otherwise provided in this section:

(i) When the application is involved in an interference (see § 41.202 of this title) or derivation (see part 42 of this title) proceeding;

(ii) When necessary to overcome the date of a reference relied upon by the examiner; or

(iii) When deemed necessary by the examiner.

(3) An English language translation of a non-English language foreign application is not required except:

(i) When the application is involved in an interference (see § 41.202 of this title) or derivation (see part 42 of this title) proceeding;

(ii) When necessary to overcome the date of a reference relied upon by the examiner; or

(iii) When specifically required by the examiner.

(4) If an English language translation of a non-English language foreign application is required, it must be filed together with a statement that the translation of the certified copy is accurate.

(h) Foreign intellectual property office participating in a priority document exchange agreement. The requirement in paragraphs (c), (f), and (g) of this section for a certified copy of the foreign application to be filed within the time limit set forth therein will be considered satisfied if:

(1) The foreign application was filed in a foreign intellectual property office participating with the Office in a bilateral or multilateral priority document exchange agreement (participating foreign intellectual property office), or a copy of the foreign application was filed in an application subsequently filed in a participating foreign intellectual property office that permits the Office to obtain such a copy;

(2) The claim for priority is presented in an application data sheet (§ 1.76(b)(6)), identifying the foreign application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, and the applicant provides the information necessary for the participating foreign intellectual property office to provide the Office with access to the foreign application;

(3) The copy of the foreign application is received by the Office from the participating foreign intellectual property office, or a certified copy of the foreign application is filed, within the period specified in paragraph (g)(1) of this section; and

(4) The applicant files a request in a separate document that the Office obtain a copy of the foreign application from a participating intellectual property office that permits the Office to obtain such a copy if the foreign application was not filed in a participating foreign intellectual property office but a copy of the foreign application was filed in an application subsequently filed in a participating foreign intellectual property office that permits the Office to obtain such a copy. The request must identify the participating intellectual property office and the subsequent application by the application number, day, month, and year of its filing in which a copy of the foreign application was filed. The request must be filed within the later of sixteen months from the filing date of the prior foreign application or four months from the actual filing date of an application under 35 U.S.C. 111(a), within four months from the later of the date of commencement (§ 1.491(a)) or the date of the initial submission under 35 U.S.C. 371 in an application entering the national stage under 35 U.S.C. 371, or with a petition under paragraph (e) of this section.

(i) Interim copy. The requirement in paragraph (f) of this section for a certified copy of the foreign application to be filed within the time limit set forth therein will be considered satisfied if:

(1) A copy of the original foreign application clearly labeled as “Interim Copy,” including the specification, and any drawings or claims upon which it is based, is filed in the Office together with a separate cover sheet identifying the foreign application by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, and stating that the copy filed in the Office is a true copy of the original application as filed in the foreign country (or intellectual property authority);

(2) The copy of the foreign application and separate cover sheet is filed within the later of sixteen months from the filing date of the prior foreign application or four months from the actual filing date of an application under 35 U.S.C. 111(a), or with a petition under paragraph (e) of this section; and

(3) A certified copy of the foreign application is filed within the period specified in paragraph (g)(1) of this section.

(j) Requirements for certain applications filed on or after March 16, 2013. If a nonprovisional application filed on or after March 16, 2013, claims priority to a foreign application filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the nonprovisional application, four months from the date of entry into the national stage as set forth in § 1.491 in an international application, sixteen months from the filing date of the prior-filed foreign application, or the date that a first claim to a claimed invention that has an effective filing date on or after March 16, 2013, is presented in the nonprovisional application. An applicant is not required to provide such a statement if the applicant reasonably believes on the basis of information already known to the individuals designated in § 1.56(c) that the nonprovisional application does not, and did not at any time, contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013.

(k) Inventor's certificates. An applicant in a nonprovisional application may under certain circumstances claim priority on the basis of one or more applications for an inventor's certificate in a country granting both inventor's certificates and patents. To

claim the right of priority on the basis of an application for an inventor's certificate in such a country under 35 U.S.C. 119(d), the applicant when submitting a claim for such right as specified in this section, must include an affidavit or declaration. The affidavit or declaration must include a specific statement that, upon an investigation, he or she is satisfied that to the best of his or her knowledge, the applicant, when filing the application for the inventor's certificate, had the option to file an application for either a patent or an inventor's certificate as to the subject matter of the identified claim or claims forming the basis for the claim of priority.

(l) Time periods not extendable. The time periods set forth in this section are not extendable.

Date: March 7, 2013. _____
Teresa Stanek Rea
Acting Under Secretary of Commerce for Intellectual Property and
Acting Director of the United States Patent and Trademark Office

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